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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/351,617	07/12/1999	VIMAL D. MEHTA	15966-518-(C	9990

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MINTZ, LEVIN, COHN, FERRIS, GLOVSKY  
AND POPEO, P.C.  
ONE FINANCIAL CENTER  
BOSTON, MA 02111

EXAMINER

PONNALURI, PADMASHRI

ART UNIT PAPER NUMBER

1639

DATE MAILED: 03/20/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Advisory Action

Application No.  
09/351,617

Applicant(s)  
Mehta et al

Examiner  
Padmashri Ponnaluri

Art Unit  
1639

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

THE REPLY FILED Feb 25, 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

## THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☒ Applicant's reply has overcome the following rejection(s):  
New matter rejection of record
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
see the attached
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: NONE
- Claim(s) objected to: NONE
- Claim(s) rejected: 1, 6, 12-20, 23, 24, 26, 27, and 31-35
- Claim(s) withdrawn from consideration: NONE
8. ☒ The proposed drawing correction filed on 2/25/03 is a) ☒ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

PADMASHRI PONNALURI  
PRIMARY EXAMINER  
ART UNIT 1639

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### ADVISORY ACTION

1. The proposed amendments and declaration filed on 2/25/03 have been considered.
2. The proposed amendments upon entering would overcome the new matter rejection.
3. The proposed amendments would not be entered into the application for the following reasons:

a) the propose amendments would not place the application in condition for allowance.

b) Applicants have not provided reasons why these amendments were not presented earlier.

4. The rejection of claims under 35 U. S. C. . 112, second paragraph for being incomplete claim, set forth in the previous office action mailed on 3/12/02 is maintained for the reasons of record.

Applicants arguments regarding this rejection has been considered. Applicants argue that 'the method step c) permitting the hybrid ligand...' is amended to include 'irreversible bond'. However, this would not overcome the rejection, since the method steps recite 'permitting' thus the method has specific and distinct reaction conditions or reagents such that an irreversible bond between the ligand A and target is permitted. The reaction conditions are controlled such that the irreversible bond is formed, which are missing in the instant claims.

5. The declaration by Inventor Thomas P. Jarvie under 37 CAR 1.132 filed on 2/25/03, is insufficient to overcome the rejection of claims 1, 6, 12-20, 23-24, 26-27 and 31-35, based upon Licitra et al (PNAS, 1996) and US Patent 5,928,868 (Liu et al) as set forth in the last Office

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action because: the declaration states that 'the chemical hybrid system of the present invention requires that ligand A forms an irreversible covalent bond with its target...', which is interpreted as that the ligand A is specific or preselected such that it forms a irreversible bond with the target. However, the instant claims do not recite any specific Ligand A and target which form a irreversible covalent bond.

The declaration is based on schematic description of the claimed invention. However, the declaration does not discuss how the claimed method is distinct from the reference methods. Further the declaration does not discuss or show that in the prior art methods Ligand A does not form a irreversible covalent bond with its target.

The declaration states that Ligand A has a specificity for a predetermined target X fusion protein such that A and X form an irreversible covalent bond upon binding. However, the instant claims do not recite any specific ligand A and target which form irreversible covalent bond. The instant claims do not recite the reaction conditions in which a irreversible covalent bond is formed.

6. Applicants response based on the declaration by Inventor Jarvie have been considered and are not persuasive for the reasons discussed supra.
7. The art rejections of record have been maintained for the reasons of record.
8. No claims are allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Ponnaluri whose telephone number is (703) 305-3884. The examiner is on *Increased Flex Schedule* and can normally be reached on Monday to Friday from 7.00 AM to 3.30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang, can be reached on (703) 306-3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

P. Ponnaluri  
Primary Examiner  
Technology Center 1600  
Art Unit 1639  
19 March 2003

  
PADMASHRI PONNALURI  
PRIMARY EXAMINER